UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,718	06/25/2001	Dale W. Malik	BELL-0105/01031	2081

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WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER
NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/888,718	MALIK, DALE W.
	Examiner	Art Unit	
	Quang N. Nguyen	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 August 2005</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-12 and 15-26</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1,3-12 and 15-26</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>25 June 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some *   c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>20050802</u>.
4)☒ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. <u>20050607</u>.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

Detailed Action

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/02/2005 has been entered.

Claims 1, 8, 16, 18 and 21 have been amended. Claims 2 and 13-14 have been canceled. Claims 25-26 have been added as new claims. Claims 1, 3-12 and 15-26 remain for examination.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   **Claims 1, 3, 7 and 16-17 area rejected under 35 U.S.C. 103(a) as being**

unpatentable over Greenstein (US 6,266,692), in view Schiavone et al. (US

2002/0120702 A1), herein after referred as Schiavone.

4.   As to claims 1 and 3, Greenstein teaches a method for filtering email using a

header-based password, comprising:

receiving an email from an email source (IPS receives *advertisement emails from*

an advertiser as in steps 102-104) (Greenstein, Fig. 1 and C3: L.39-42);

identifying whether the email has a vendor registration code *(i.e., passcode)* for

identifying a vendor from whom the email was forwarded *(ISP email server checks*

passcodes of all received emails as in step 106) (Greenstein, Fig. 1 and C3: L42-44);

if the email has a vendor registration code that was previously assigned to the

email source, presenting the email with other emails having vendor registration codes

(determining if the received email has a valid passcode, the email server approves the

email at step 108 and sends the email to the user's mail inbox at step 110) (Greenstein,

Fig. 1 and C3: L40-49); and

if the email does not have a vendor registration code that was previously

assigned to the email source, sending a message to the email source *(if a sender did*

not specify a passcode when sending to the user who requires such passcode, the

unwanted/unapproved email is stored in a temporary storage until deleted or approved

and the mail server may additionally send a reply email back to the sender) (Greenstein,

C2: L36-39 and C3: L52-67).

However, Greenstein does not explicitly teach identifying whether the email has a vendor registration purpose code for identifying the purpose of the email and presenting the email with other emails having the same vendor registration code and vendor registration purpose code.

In a related art, Schiavone teaches a system and method for categorization and categorized display of messages in a recipient's inbox which is divided into sections acting like multiple inboxes, each section displaying messages falling in a certain corresponding category *(i.e., presenting the email with other emails having the same vendor registration purpose code)*, wherein the new email message is associated with a category by reading of a message identifier from header information of the new email message *(identifying whether the email has a message identifier associated with a certain corresponding category, i.e., identifying a vendor registration purpose code identifying the purpose of the email)* and determining whether the message identifier matches the category identifier *(i.e., determining whether the email has a valid vendor registration purpose code)* (Schiavone, Figs. 6-7 and [0054-0055]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Greenstein and Schiavone to include a vendor registration purpose code to identify the purpose of the email and presenting the email with other emails having the same vendor registration code and vendor registration purpose code since such methods were conventionally employed in the art to allow the system to enhance the efficacy of the email messaging and counteract dilution caused by receipt of numerous, unimportant email messages by segregating mail into meaningful categories *(i.e., purposes)* (Schiavone, [0048]).

5.   Claim 7 is a corresponding computer readable medium claim of method claim 1; therefore, it is rejected under the same rationale.

6.   Claims 16-17 are corresponding method claims of method claim 1; therefore, it is rejected under the same rationale.

7.   **Claims 4-6, 8-12, 15 and 18-26 area rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein-Schiavone, and further in view of Paul (US 5,999,932).**

8.   As to claims 4-5, Greenstein-Schiavone teaches the method of claim 1, but does not explicitly teach identifying the username and the source from which the email was forwarded and identifying whether the username and source of the email message identify a valid contact.

In a related art, Paul teaches a system and method for filtering unsolicited emails generating and storing a user inclusion list including identification data *(such as list of valid/approved email addresses or groups of email addresses organized by domain)* for identifying email desired by the user, wherein upon receipt of an email message, the email filter retrieves data from selected fields *(such as FROM, TO, CC, etc.)* of the received email message and compares the retrieved data with data stored in the corresponding category of the user inclusion list *(i.e., identifying whether the username and source identify a valid contact)* (Paul, C7: L52-62 and C8: L17-31).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Greenstein-Schiavone and

Paul to check whether the username and source of the email message identify a valid contact since such methods were conventionally employed in the art to sort out email messages by comparing one or more predetermined data fields (such as *username and domain) of* each email message with data stored in an automatically updated database of acceptable addresses and domains *(inclusion lists)* to determine if email messages are of potential interest to the user or just "junk" or "spam" email messages.

9.   As to claim 6, Greenstein-Schiavone-Paul teaches the method of claim 5, further comprising identifying a source category corresponding to the source identified for the email *(i.e., identifying the "FROM" field has a domain that matches one of a pre-defined list of domains that assured to be junk-free such as corporations or government organizations)* (Paul, C9: 1.34-45).

10.   Claim 8 is a corresponding combination method claim of method claims 1 and 4-6; therefore, it is rejected under the same rationale.

11.   As to claims 9-10, Greenstein-Schiavone-Paul teaches the method of claim 8, further comprising if the email is not from a source in a contact list and does not have a vendor registration code that was previously assigned to the email source *(if there is no passcode, the email is held temporary in a holding tank, until the receiver approves to receive the email)* (Greenstein, C3: L52-57), presenting the email with other emails that are not from a source that is identified in a contact list and do not have a vendor registration code *(i.e., placing the message in a folder according to its status as "OK", "NEW" or "JUNK", i.e., not "OK")* (Paul, C9: L7-47).

12.   As to claims 11-12, Greenstein-Schiavone-Paul teaches the method of claim 9,
further comprising parsing the email to identify at least one of the following: a user name
from whom the email was forwarded; and a source from which the email was forwarded
and further comprising comparing the username and source to the contact list to
determine if the email is from a source that is identified in the contact list *(upon receipt*
of an email *message, the email filter retrieves data from the "FROM" field of the*
received email and compares the field data retrieved from the received message with
data stored in the corresponding category of the inclusion list) (Paul, C8: L17-27).

13.   Claim 15 is a corresponding computer readable medium claim of method claim 8;
therefore, it is rejected under the same rationale.

14.   Claims 18-20 are corresponding system claims of method claims 8-10;
therefore, they are rejected under the same rationale.

15.   Claims 21-26 are corresponding method claims of method claims 4 and 8-10;
therefore, they are rejected under the same rationale.

16.   Applicant's arguments as well as request for reconsideration filed on
08/02/2005 have been fully considered but they are not deemed to be persuasive.

17. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RUPAL DHARIA
SUPERVISORY PATENT EXA!'